



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,464	06/14/2001	Stephen O. Friend	100647-3950	1175

31013 7590 02/03/2004

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
919 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 02/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/882,464

Applicant(s)

FRIEND ET AL.

Examiner

Elena Tsoy

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 and 23-28 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-22 is/are allowed.
- 6) ☒ Claim(s) 12-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Response to Office Action

Response filed on December 11, 2003 has been entered. Claims 1-28 are pending in the application. Claims 1-12 and 23-28 are withdrawn from consideration as directed to a non-elected invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 12-18** stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rzepecki et al (US 4,414,260) in view of Nahass et al (US 5,591,382) for the reasons of record as set forth in Paragraph No. 3 of the Office Action mailed on June 9, 2003 (Paper No. 11).

Allowable Subject Matter

3. **Claims 19-22** stand allowed for the reasons of record as set forth in Paragraph No. 4 of the Office Action mailed on June 9, 2003 (Paper No. 11).

Response to Arguments

4. Applicants' arguments filed December 11, 2003 have been fully considered but they are not persuasive.

(A) Applicants argue that prima facie case of obviousness has not been established because there must be some teaching or suggestion in the cited references (and not by hindsight

Art Unit: 1762

gleaned from the Applicants' specification) to motivate one of ordinary skill in the art at to modify Rzepecki et al with Nahass et al to obtain claimed invention.

The Examiner respectfully disagrees with this argument. Rzepecki et al disclose a process for making a multilayered **static-dissipative polymeric structure** for protecting appliances three layers 10-11-12 of differently conductive polymeric material (See Figs. 1, 2; column 2, lines 25-29), each layer having conductive ingredients such as carbon black so that to achieve the same surface resistance of 10^8 ohms per square for layers 10 (a first polymeric layer) and 12 (a third polymeric layer), which is higher than the surface resistance of 300 ohms per square of the intermediate layer 11 (a second polymeric layer) (See column 2, lines 59-68).

On the other hand, Nahass et al teach that 0.25-50 wt % of carbon fibrils with one or more selected polymeric materials can be used for making a conductive, **static-dissipative** polymeric structure having commercially acceptable conductivity of e.g. volume resistivity of less than about 10^{11} ohm-cm (See column 3, lines 6-40). **Carbon fibrils have been used in place of carbon black** in a number of applications. For example, it has been recognized that the addition of carbon fibrils to polymers in quantities less than that of carbon black, can be used to produce conductive end products. See column 1, lines 54-57. Conductive compounds containing carbon fibrils have significantly higher toughness than do compounds containing highly-conductive carbon black. A carbon black loaded polymeric compound with the same conductivity level as a fibril loaded polymeric compound does not have mechanical properties which are as good as the fibril loaded polymeric compounds (See Examples 5A, 5B and 5D). Fibril polymeric compounds with the same filler loading level as carbon black have better notched impact strength and conductivity. See column 16, lines 46-59.

Therefore, clearly, one of ordinary skill in the art at would have motivation and reasonable expectation of success in substituting carbon black in static-dissipative polymeric structure of Rzepecki et al with carbon fibrils with the expectation of providing the static-dissipative polymeric structure with desired conductivity using fewer amounts of carbon fibrils and toughness, as taught by Nahass et al.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(B) Applicants argue that (i) Rzepecki et al is directed to a multi-layer conductive web for use as an upholstery material and the like, i.e. not like materials like housings, trays or packaging materials of claimed invention. (ii) Nahass, on the other hand, is directed to high strength conductive polymers with superior toughness; and there is no mention or suggestion anywhere in Nahass for using his invention to form upholstery, fabric or the like. (iii) As such Rzepecki et al and Nahass are in completely different fields and applications.

As to (i), Rzepecki et al is directed to a multi-layer static-dissipative web construction, suitable for example as an upholstery material or the like, to enable personnel-accumulated static electricity to safely discharge from a person seated upon or leaning against an upholstered stool or other furniture or **appliance** (See column 1, line 16). In other words, the static-dissipative web

construction of Rzepecki et al includes covering for appliances, i.e. housing, packaging material, not just upholstery.

As to (ii), Nahass teaches that carbon fibrils have been used in place of carbon black in a **number of** applications. It has been recognized that the addition of carbon fibrils to polymers can be used to **enhance** the **tensile** and **flexural** characteristics of end products (See column 1, lines 61-63). A fibril loaded polymeric composition is ultimately formed into a preselected shape by injection molding, blow molding, RIM, **extrusion** (i.e. flexible web construction), etc. (See column 7, lines 29-52).

One of ordinary skill in the art at would be motivated to substitute carbon black with carbon fibrils even in upholstery material and the like to **enhance** the **tensile** and **flexural** characteristics of the upholstery material. Clearly the same applies to coverings (housings) for appliances.

As to (iii), since Nahass teaches that carbon fibrils have been used in place of carbon black in a **number of** applications, and a fibril loaded polymeric composition is ultimately formed into a preselected shape by *injection molding, blow molding, RIM, extrusion*, Nahass covers any possible field where conductive polymers are used.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

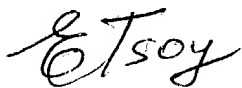
Art Unit: 1762

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30, Mo-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Elena Tsoy
Examiner
Art Unit 1762

January 29, 2004